

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claims 1-15, 20, and 22 under 35 U.S.C. § 103 as unpatentable over U.S. Patent App. Pub. No. 2002/0018228 to Torigoe ("Torigoe") in view of U.S. Patent No. 7,309,017 to Zaba et al. ("Zaba").

Claims 1-22 remain pending, and claims 16-19 and 21 have been withdrawn.

Applicants respectfully traverse the rejection under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original). In this application, a *prima facie* case of obviousness has not been

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

established because the Examiner has not clearly articulated a reason why one of ordinary skill would find the claimed combination obvious in view of the cited references.

Claim 1 recites a image forming device including, for example:

...  
a printing unit for printing the specified mark on a recording element including an IC tag when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job; and  
a writing unit for writing mark information indicating the specified mark's content on the IC tag included in the recording element when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job.

(emphasis added).

As an initial matter, Applicants note that the instruction used by the "printing unit" as the trigger for the printing the "specified mark" and the instruction used by the "writing unit" as the trigger for the writing the "mark information" are identical. Accordingly, a single "instruction" is used for two different operations.

*Torigoe* discloses an image processing apparatus including a judging means and a control means (paragraph 0023). The Examiner correctly states that *Torigoe* does not teach or suggest the claimed "printing unit" and "writing unit" (Office Action at page 5).

*Zaba* does not cure the deficiencies of *Torigoe*. *Zaba* discloses an "apparatus 110 for printing onto a base medium and data writing to a memory tag in or on the base medium" (col. 5, lines 25-27 and Figs. 4 and 5). In *Zaba*, "security document 901 contains printed material and a signature strip 902, signed by an authorised bearer. Embedded within the security document 901 is a memory tag 903 embedded in a tamper-resistant region 903" (col. 11, lines 48-52 and Fig. 9).

While *Zaba* discloses a security document that includes signature strip 902, *Zaba* fails to teach or suggest receiving a single instruction used for two different operations, namely for (1) "printing the specified mark on a recording element including an IC tag" and (2) "writing mark information indicating the specified mark's content on the IC tag included in the recording element" as recited in claim 1.

Accordingly, the combination of *Torigoe* and *Zaba* does not teach or suggest claim 1. Furthermore, as outlined above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Therefore, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art and a *prima facie* case of obviousness has not been established.

Claim 1 is thus allowable, and claims 2-15 are also allowable at least due to their depending from claim 1. Independent claims 20 and 22, while of different scope, recites elements similar to those of claim 1 and are thus allowable over *Torigoe* and *Zaba* for at least the same reasons discussed above in regard to claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 3, 2010

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